

REMARKS

Claims 1-14 are pending in the present application. In response to the restriction requirement, claims 10-14 have been withdrawn leaving claims 1-9 for consideration.

The specification has been amended to correct typographical errors and to conform to amendments made to the claims. In particular, the amendment on page 1 (-C(=O)O-) conforms to amended claim 1. The amendments on pages 3 and 14 correct a typographical error in the tetravalent radical formula, and correspond to amended claim 3. The amendment on page 4 corrects a typographical error ( $R_1$  should have been  $R_5$ ), and corresponds to amended claim 6. The amendment on page 5 is supported by the specification at page 2, first line (when  $R_2$  is hydrogen, then  $R_5$ -NH- $R_2$  contains an -NH<sub>2</sub> group). The amendments on pages 7 and 11 correct typographical errors. The amendments to pages 12-14 and 16 more precisely describe the example in terms of the language used in other portions of the specification, such as, e.g., page 1 (formulae Ia and Ib), pages 5 and 6 (formulae IIa and IIb), and pages 5-7 (use of various amine reagents in the preparation of compounds of formulae Ia or Ib). The amendments contain no new matter.

I. Certified Copy of Priority Document

The Examiner acknowledges Applicants' claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f); yet indicates that no certified copies of the priority documents have been received. The PCT Request form submitted to the International Bureau indicates that the priority document accompanied the International Application (Box VIII; copy attached hereto). The Office may request a copy of the priority document from the International Bureau according to PCT Rule 17.2(a). Applicants respectfully request that the Examiner notify Applicants if the Office is unable to obtain the priority document from the International Bureau.

II. Restriction Requirement and Species Election

The Examiner requires restriction to one of the following inventions:

Group I: claims 1-9, drawn to a polymercaptopolyamine;

Group II: claims 10 and 12-14, drawn to a composition comprising an epoxy resin and a polymercaptopolyamine; or

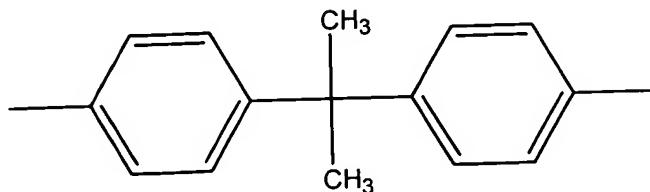
Group III: claims 11 and 12, drawn to a composition comprising an epoxy resin, a polymercaptopolyamine and a polyamine.

The Examiner also requires a species election to either the polymercaptopolyamine of formula Ia or Ib, wherein X, A, E, R<sub>1</sub> and R<sub>5</sub> are identified. If Group II or III is elected, a further election of the particular epoxy is required, such as electing the diglycidyl ether of bisphenol A listed on page 17, line 3 of the specification. If Group III is elected, an election of the particular polyamine is required, such as electing diethylenetriamine (DETA) as recited in the example on page 17 of the specification.

During a telephone conversation with Applicant's representative on May 13, 2003, a provisional election was made to prosecute the invention of Group I, claims 1-9 and the compound of formula Ia wherein

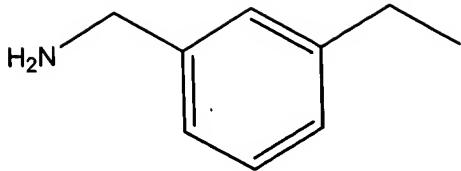
X is O;

A is



R<sub>1</sub> is hydrogen; and

R<sub>5</sub> is



Applicants presently affirm the provisional election (with traverse) and hereby elect Group I, claims 1-9, drawn to a polymercaptopolyamine of formula Ia wherein X, A, R<sub>1</sub> and R<sub>5</sub> are defined as above. Claims 10-14 have been withdrawn. Applicants respectfully request that claims 10-14 be rejoined when the Examiner determines that the "special technical feature" common to claims 1-14, the polymercaptopolyamine, makes a contribution over the prior art.

III. Rejections under 35 U.S.C. § 112, First Paragraph and Second Paragraph

Claims 1-9 stand rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the enablement requirement. Claims 1-9 stand rejected under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite.

Applicants have obviated these grounds for rejection by amending claim 1 to omit the radical -CHR<sub>4</sub> as the substituent X in formula Ia and Ib, and consequently by deleting the phrase "with R<sub>4</sub> and R<sub>3</sub> together forming an ethylene group." In addition, the ester moiety within the limits of X has been amended to affirmatively illustrate the carbonyl oxygen. Furthermore, claim 6 has been amended to change R<sub>1</sub> to R<sub>5</sub>. The original reference to R<sub>1</sub> was a typographical error. Accordingly, Applicants respectfully request that the 112 rejection be withdrawn.

VI. Rejection under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103(a)

Claims 1, 4, 5 and 8 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Luhowey et al. (U.S. Patent No. 3,919,277) or Levine (U.S. Patent No. 3,548,002) or Cameron (U.S. Patent No. 3,394,098).

In the interest of expediting prosecution of this application, Applicants have obviated this ground for rejection by amending the claims to define the substituent X of formula Ia and Ib as being either an oxygen atom or an ester group. Accordingly, Applicants respectfully request that the 102(b) and 103(a) grounds for rejection be withdrawn.

### CONCLUSION

Applicants believe that the present application is now in condition for allowance. Favorable consideration of the application as amended is respectfully requested.

Respectfully submitted,

Proskauer Rose LLP

Date: November 21, 2003

By

*Kristin H. Neuman*  
Kristin H. Neuman  
Attorney for Applicants  
Registration No. 35,530

Proskauer Rose LLP  
Patent Department  
1585 Broadway  
New York, NY 10036-8299  
Tel. (212) 969-3686 (direct)  
Fax (212) 969-2900